

REMARKS

I. Introduction

Claims 1 to 59, 61, 62 and 64 to 72 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant has amended the Specification to reference U.S. Provisional Patent Application Serial No. 60/212,680, entitled "Tracking Surgical Implements With Integrated Circuits," filed on June 20, 2000.

II. Rejection of Claims 49 to 54, 56 to 59, 66 and 68 to 72 Under 35 U.S.C. § 102(e)

Claims 49 to 54, 56 to 59, 66 and 68 to 72 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,366,206 ("Ishikawa et al."). See Office Action at p. 3. Applicant respectfully submits that Ishikawa et al. do not anticipate claims 49 to 54, 56 to 59, 66 and 68 to 72 for the following reasons.

For convenience, independent claim 49 is reproduced below:

49. (Previously Presented) A medical label system comprising:

a label including at least one integrated circuit, wherein the integrated circuit uniquely identifies a medical product the label is attached to by transmitting a radio frequency identifier (RFID) for the medical product in response to an RF signal; and

a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to track a location of the medical product based on the RFID.

Ishikawa et al. purportedly relate to a method and apparatus for attaching tags to medical and non-medical devices. Ishikawa et al. state that transponder 15 may be used to tag any medical product or device, or non-medical products or devices. See col. 8, lines 26 to 29. Ishikawa et al. further state that before closing the patient's body at the site of the surgery, the site would be scanned with the monitoring unit 17 and that if a sponge ball transponder 15 were to respond, the sponge could be located and removed. See col. 8, lines 32 to 35. Ishikawa et al.

further state that the instruments would be scanned before surgery to generate an inventory and that at the end of the surgery the surgical suite could be scanned to account positively for all items in the inventory. See col. 8, lines 37 to 41.

The Office Action alleges, without any support, that Ishikawa et al. disclose a computer system (17) which tracks the location of the medical product. Respectfully, as indicated above, Ishikawa et al. merely disclose scanning the medical instruments before surgery to generate an inventory and scanning the entire surgical suite to account positively for all items in the inventory after the surgery. Nowhere do Ishikawa et al. disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to **track a location of the medical product** based on the RFID, as recited in claim 49. As can be seen in Figure 3, Applicant uses a location field 180 to **track the location**, e.g., the garbage, the main table, etc., of the medical product in question, not just to account for all medical product in inventory at the end of the surgical procedure as Ishikawa et al. disclose. Therefore, Ishikawa et al. do not disclose all of the limitations of claim 49.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Ishikawa et al. do not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to **track a location of the medical product** based on the RFID, as recited in claim 49. Therefore, Ishikawa et al. do not anticipate claim 49. Accordingly, withdrawal of the 35 U.S.C. § 102 (e) rejection and allowance of claim 49 are respectfully requested.

As for claims 50 to 54, 56 to 59, 66 and 68 to 72, which ultimately depend from claim 49 and therefore include all of the limitations of claim 49, it is respectfully submitted that Ishikawa et al. do not anticipate these dependent claims for at least the same reasons provided above in support of the patentability of claim 49. Therefore, withdrawal of the 35 U.S.C. § 102 (e) rejection and allowance of claims 50 to 54, 56 to 59, 66 and 68 to 72 are respectfully requested.

III. Rejection of Claims 54 to 59, 61, 62 and 69 to 72 Under 35 U.S.C. § 103(a)

Claims 54 to 59, 61, 62 and 69 to 72 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ishikawa et al. See Office Action at p. 4. Applicant respectfully submits that Ishikawa et al. do not render unpatentable claims 54 to 59, 61, 62 and 69 to 72 for the following reasons.

Claims 54 to 59, 61, 62 and 69 to 72 ultimately depend from claim 49 and therefore includes all of the limitations of claim 49. As indicated above, Ishikawa et al. do not disclose all of the limitations of claim 49. Specifically, Ishikawa et al. do not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to track a location of the medical product based on the RFID, as recited in claim 49. Therefore, Ishikawa do not disclose all of the limitations of claims 54 to 59, 61, 62 and 69 to 72.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, Ishikawa et al. do not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to track a location of the medical product based on the RFID, as recited in claim 49. Therefore, Ishikawa does not render obvious claims 54 to 59, 61, 62 and 69 to 72, which ultimately depend from claim 49. Accordingly, withdrawal of the 35 U.S.C. § 103 (a) rejection and allowance of claims 54 to 59, 61, 62 and 69 to 72 are respectfully requested.

IV. Rejection of Claim 67 Under 35 U.S.C. § 103(a)

Claim 67 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Ishikawa et al. and U.S. Patent No. 6,313,747 ("Imaichi et al."). See Office Action at p. 4. Applicant respectfully submits that the combination of Ishikawa et al. and Imaichi et al. does not render unpatentable claim 67 for the following reasons.

Claim 67 depends from claim 49 and therefore includes all of the limitations of claim 49. Imaichi et al. purportedly relate to a resonant tag including an insulating thin film and coiled circuits made of a metal foil. See Abstract. Imaichi et al. do not remedy, nor are Imaichi et al. relied upon for remedying, the above detailed deficiencies of Ishikawa et al. Therefore, the combination of Ishikawa et al. and Imaichi et al. does not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID to receive the RFID and to track a location of the medical product based on the RFID, as recited in claim 49. Therefore, the combination of Ishikawa et al. and Imaichi et al. does not render obvious claim 67. Accordingly, withdrawal of the 35 U.S.C. § 103 (a) rejection and allowance of claim 67 are respectfully requested.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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